

In the Office Action of April 17, 2002, the Examiner indicated that the amendment submitted on January 23, 2002 was improper for failing to comply with the requirements of 37 C.F.R. §1.173. In particular, it was indicated that claims 28-45 and 53-73 should be underlined because they are new to the original patent. The Office Action also indicated that the requirements of 37 C.F.R. §1.121 did not apply to reissue practice. It was also indicated that the text portion should include where the changes find support in the specification

Applicants have reviewed the requirements of 37 C.F.R. §1.173 and made appropriate changes to the amendment in order to comply with the requirements of 37 C.F.R. §1.173. Applicants have also indicated where support for changes can be found in the specification. More particularly, support can be found at, for example: original claims 15 and 18; column 4, lines 12-54 and lines 55-66; column 5, lines 40-64; column 8, lines 63-67; column 10, lines 3-32; column 17, lines 33-55.

The Examiner's indication that claims 1-15, 20, and 23-27 are allowed, is noted with appreciation.

Claim 24 has been amended to correct a typographical error.

Objection to the drawings

In the Office Action of October 24, 2001, the drawings were rejected to because the Patent and Trademark Office no longer transfers drawings from patent files.

Applicants are submitting a new set of drawings to be included with the current file. Withdrawal of this objection is respectfully requested.

Information Disclosure Statement

The Office Action indicates that the Information Disclosure Statement (IDS) submitted on June 26, 2000 appears to be for the wrong application because the identification information does not correspond to the instant application.

Upon reviewing the IDS and the file, applicants are inclined to agree with the Examiner. It appears as though the referenced 1449 Form was erroneously filed in the present application. Applicants therefore respectfully request that this material be disregarded, or otherwise removed from the file.

Objection to Reissue Declaration

The Reissue oath/declaration filed with the application was objected to as being defective for failing to identify at least one error which is relied upon to support the Reissue application.

The Office Action indicates that the declaration did not sufficiently specify, or give a proper example of the error. Rather, the example set forth in the declaration was indicated as stating only that the error pertains to "omission of broader claims to an operator assisted prescription dispensing system and a method of dispensing pills in a prescription dispensing system." This was not considered an error because the Office Action indicates that the patent inherently applies to the operator assisted system and method as set forth in the original claims.

Applicants respectfully disagree with this assertion. The declaration is not defective because it, in fact, identifies at least two errors being relied upon with specificity. As discussed in the Disclosure, one aspect (or embodiment) of the invention can involve the assistance of an operator who manually retrieves the pills that are being dispensed. Even if this aspect is considered to be inherently incorporated within the original claims, such "inherency" would necessarily be of a different scope of protection than claims that do not contain inherent

limitations but where such limitations are expressly recited. In any event, Applicants have adapted the specific language suggested in 37 C.F.R. §1.175 and M.P.E.P. §1414 which states, in part, "Applicant believes the original patent to be partly inoperative or invalid by reason of the patentee claiming more or less than patentee had the right to claim in the patent."

Applicants therefore respectfully submit that the oath/declaration is not defective and does not require any changes because the error relied upon was clearly identified.

Rejection Under 35 U.S.C. §251 for Improper Recapture

Claims 28-54 were rejected under 35 U.S.C. §251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present Reissue application is based. The Office Action indicates that original, unamended claim 15 of the parent patent is substantially equivalent to claim 28, which was submitted with the Reissue application. Original claim 15 was allowed after an amendment which incorporated the subject matter of dependent claim 18 therein to obtain allowance. The Office Action further indicates that the remaining claims submitted with the Reissue application are obvious language variations of claims 15 and 28.

Newly presented claims 28-72 have been prepared to include the limitations of original claim 18. Thus, the subject matter of claims 28-72 is not believed to have been surrendered during prosecution.

Applicants therefore respectfully submit that, as amended, claims 28-54 do not represent a recapture of previously surrendered subject matter, and respectfully request withdrawal of this rejection.

Objection to the Reissue Application

The Office Action also objects to the application under several grounds as lacking various papers. For example, the Office Action indicates that the application lacks a proper written consent of all assignees owning an undivided interest in the patent. The Reissue application is also indicated as being filed without a proper offer to surrender the original patent. A proper assent of the assignee is also indicated as lacking. The Office Action notes, however, that copies of these forms appear to be on file although they are not signed.

Applicants are unaware of ever having filed such papers without appropriate signatures. Review of applicants' file has revealed fully executed copies of these documents. Applicants therefore are including with this response, copies of the above-referenced documents as filed on October 27, 2000, together with the stamped postcard from the Patent Office. Withdrawal of these objections is therefore respectfully requested.

Prior Art Rejections

Claims 16 and 46 were rejected under 35 U.S.C. §102(b) as being clearly anticipated by U.S. Patent No. 5,208,762 issued to Charhut. Claims 21 and 52 were rejected under 35 U.S.C. §102(b) as being clearly anticipated by U.S. Patent No. 4,953,745 issued to Rowlett. Claims 28-45, 54, and 55 were rejected under 35 U.S.C. §102(b) as being clearly anticipated by either U.S. Patent No. 4,664,289 issued to Shimizu, Rowlett, or Charhut. Claims 49-51 were rejected under 35 U.S.C. §102(b) as being clearly anticipated by Charhut. Claims 17 and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Charhut in view of U.S. Patent No. 3,139,713 issued to Merrill. Claim 18 was rejected under 35 U.S.C. §103(a) as being unpatentable over Charhut. Claims 16, 18, and 46 were rejected under 35 U.S.C. §103(a) as being unpatentable over Shimizu in view of Charhut. Claim 17 was rejected under 35 U.S.C.

§103(a) as being unpatentable over Shimizu in view of Charhut and further in view of Merrill.

Claims 16-18 and 46 were rejected under 35 U.S.C. §103(a) as being unpatentable over admitted prior art in view of Charhut. Claim 19 was rejected under 35 U.S.C. §103(a) as being unpatentable over admitted prior art. Claim 22 was rejected under 35 U.S.C. §103(a) as being unpatentable over Rowlett. Claims 47 and 49-51 were rejected under 35 U.S.C. §103(a) as being unpatentable over either Shimizu, Rowlett, or Charhut. Claims 48 and 53 were rejected under 35 U.S.C. §103(a) as being unpatentable over Charhut in view of Merrill.

These rejections are respectfully traversed.

The Charhut patent discloses an automated prescription vial filling system. The system generally provides for dispensing of drugs, wherein a patient's order of one or more prescriptions can be automatically filled. Three or more filler lines are used to store various drugs, and a vial size is assigned to each line. When a prescription is filled, it is automatically assigned to one of the lines based on the vial size requirements. The Charhut patent also provides an ability to collect all of a patient's prescriptions so that they may be consolidated into a single order. The Charhut patent, however, does not appear to disclose features such as simultaneous counting and sequential dispensing of pills.

The Rowlett patent discloses a medication dispensing apparatus that is generally capable of dispensing a selected one of a plurality of drugs. A cabinet is used to house a plurality of individual dispensing mechanisms, each of which is adapted to store and dispense a plurality of a selected drug unit. A control unit is provided to generate a drug dispense signal corresponding to the selected drug and cause the appropriate dispensing mechanism to dispense the drug. The control unit can maintain an inventory of the stored drugs, and can be preprogrammed with a prescribed schedule for a particular patient such that a can be dispensed for the patient only

during a certain time period. The Rowlett patent, however, does not appear to disclose features such as simultaneous counting and sequential dispensing of pills.

The Shimizu patent generally discloses a drug dispensing apparatus that includes a drug dispensing unit and a control unit. The apparatus is capable of dispensing individual drug doses to a common collection area from one or more drug dispensing cartridges for packaging. The drug dispensing unit is internally provided with a plurality of shelves, with a plurality of drug dispensing cartridges removably disposed on each of the shelves. Each of the drug dispensing cartridges accommodates a plurality of individual identical drug doses. Each drug dosage is discharged one at a time from the cartridge through rotation of rotary members in compliance with input information received from the control unit. The Shimizu patent, however, does not appear to disclose features such as simultaneous counting and sequential dispensing of pills.

Independent claim 16 of the present invention defines an automated prescription dispensing system that comprises:

a plurality of adjacently arranged pill dispensers, each operable to count out and dispense pills of a different pharmaceutical, computer control means to store a plurality of prescriptions each specifying a different pharmaceutical in pill form and a number of pills, said computer control means selecting the pill dispensers dispensing the pharmaceuticals specified in said stored prescriptions and controlling the selected pill dispensers to simultaneously count out pills from said pill dispensers and sequentially dispense pills, said computer control means stopping each pill dispenser from counting out and dispensing pills when the number of pills specified in the corresponding prescription have been counted out and dispensed, and label means to produce prescription container labels, said computer control means causing said label means to produce prescription labels containing information corresponding to said stored prescriptions, wherein said label means produces said prescription labels one at a time and will not produce a prescription label for the next prescription until after pills specified in a preceding prescription have been received from a pill dispenser into a prescription container.

One significant feature of independent claim 16 is the manner in which the pills are counted out and dispensed. More particularly, the pill dispensers are controlled such that they

simultaneously count out the pills, but sequentially dispensed them. Consider, for example, five dispensers that will be counting out 100 pills each to be dispensed. For example, all five dispensers are initially controlled to simultaneously count out 100 pills. However, the pills from each dispenser are then sequentially dispensed. Referring to the previous example, assume that each dispenser requires 15 seconds to count 100 pills. Conventional devices would consequently require 75 seconds just for counting out the pills. According to the automated prescription dispensing system of claim 16, and one embodiment of the present invention, only 15 seconds are required to count out all the pills because the dispensers operate in parallel to simultaneously count out the pills. As can be seen, significant time savings can be realized through the use of the invention defined by independent claim 16. Advantageously, the present invention, in one embodiment, only sequentially dispenses the pharmaceuticals to ensure, for example, the appropriate pharmaceutical is dispensed in the appropriate bottle.

The Office Action alleges that the applied references anticipate and render claim 16 obvious. In support of this rejection, the Office Action indicates, for example, that Charhut discloses a pill dispensing and packaging machine that comprises all the elements recited in independent claim 16. These elements include: a plurality of pill dispensers containing different pills, computer control means to store prescriptions to count out and dispense the pills into a package and to stop the dispensers when the desired number of pills are dispensed, and a labeling device that labels containers either during or immediately after the pills have been dispensed into the containers. Shimizu is indicated as disclosing all of the features of independent claim 16 except for the use of a printer as claimed. The prior art cited in the Information Disclosure Statements are also alleged as disclosing the features recited in independent claim 16. The

Office Action also cites various passages in the references wherein it is believed the claimed features are disclosed.

Contrary to the assertions made in the Office Action, however, the applied references and the prior art cited in the IDSs do not anticipate or render independent claim 16 (or any of the pending claims) obvious. Review of the passages cited in the Office Action has not revealed any disclosure or suggestion for the specific combination of features recited in independent claim 16. For example, none of the cited references provide any disclosure or suggestion for an automated prescription dispensing system wherein pill dispensers are controlled to "**simultaneously count out pills from said pill dispensers and sequentially dispense pills,**" in combination with the remaining elements of claim 16. For example, column 3, lines 44-62 of Charhut (cited in the Office Action) does not reveal any information that the pills are simultaneously counted out, and sequentially dispensed. Likewise, the passages cited from the remaining references do not reveal any disclosure or suggestion for such features in combination with the remaining claim elements. As described earlier, in one embodiment of the present invention, great savings in dispensing time and safety are achieved as a result. No such savings are at all described in the prior art.

Specifically, the prior art fails to disclose or suggest the combination of limitations, where:

a plurality of adjacently arranged pill dispensers, each operable to count out and dispense pills of a different pharmaceutical, computer control means to store a plurality of prescriptions each specifying a different pharmaceutical in pill form and a number of pills, said computer control means selecting the pill dispensers dispensing the pharmaceuticals specified in said stored prescriptions and controlling the selected pill dispensers to simultaneously count out pills from said pill dispensers and sequentially dispense pills, said computer control means stopping each pill dispenser from counting out and dispensing pills when the number of pills specified in the corresponding prescription have been counted out and dispensed, and label means to produce prescription container labels, said computer control means causing said label means to produce prescription labels containing information corresponding to said stored prescriptions, wherein said

label means produces said prescription labels one at a time and will not produce a prescription label for the next prescription until after pills specified in a preceding prescription have been received from a pill dispenser into a prescription container.

It is therefore respectfully submitted that, as amended, independent claim 16 is allowable over the art of record.

Claims 17 and 18 depend from independent claim 16, and are therefore believed allowable for at least the reasons set forth above with respect to independent claim 16. In addition, claims 17 and 18 include additional limitations that are independently patentable. For example, claim 17 further recites "a plurality of output hoppers are provided, one for each of said pill dispensers to receive the pills counted out and dispensed by said pill dispensers, said computer control means including means to selectively permit the release of the pills from said output hoppers into prescription pill containers," in combination with the features of independent claim 16. The prior art does not provide disclosure or suggestion for such a combination of elements.

Independent claims 19 and 21 have been amended; somewhat similar to claim 16, to recite the additional features of simultaneously counting out the pills and sequentially dispensing them. As previously indicated with respect to independent claim 16, such features are not taught, shown, or in any way suggested by any of the applied references. Furthermore, the combination of features recited in claims 19 and 21 is not shown or suggested by any of the applied references.

It is therefore respectfully submitted that independent claims 19 and 21 are also allowable over the art of record.

Claim 22 depends from independent claim 21, and is therefore believed allowable for at least the reasons set forth above with respect to independent claim 21. In addition, claim 22

includes additional limitations that are independently patentable when considered in view of the combination of features recited in claim 21. More particularly, claim 22 further recites that "said means to increase said hopper quantity includes a bar code reader to read a bar code on a bulk supply container of pills to be added to the supply hopper of a given pill dispenser." Such a combination of features is not shown or suggested by the prior art.

Newly presented independent claim 28 defines an operator assisted prescription dispensing system that comprises the following combination:

An operator assisted prescription dispensing system comprising a plurality of pill dispensers, each operable to count out pills of at least one pharmaceutical, at least one computer controller responsively controlling said plurality of pill dispensers and storing a plurality of prescriptions each specifying a pharmaceutical in pill form and a number of pills, said computer controller selecting said plurality of pill dispensers dispensing the pills specified in at least one of said plurality of prescriptions and controlling said plurality of pill dispensers to simultaneously count out the pills, said computer controller stopping each pill dispenser from counting out the pills when the number of pills specified in the corresponding prescription have been counted out, said computer controller controlling said plurality of pill dispensers to sequentially dispense the pills corresponding to at least one of said plurality of prescriptions, and label means to produce prescription container labels, said computer control means causing said label means to produce prescription labels containing information corresponding to said stored prescriptions, wherein said label means produces said prescription labels one at a time and will not produce a prescription label for the next prescription until after pills specified in a preceding prescription have been received from a pill dispenser into a prescription container.

Similar to independent claim 16, claim 28 also reflects the combination of features of simultaneously counting out the pills and sequentially dispensing them. Such features have previously been indicated as lacking in the art of record. In particular, the art of record does not provide disclosure or suggestion for these features in combination with the remaining elements of claim 28. Applicants have also indicated the benefits achieved by such features. Review of the passages cited by the Office Action has not revealed any disclosure or suggestion for the

combination of features recited in independent claim 28. The applied references simply do not suggest a prescription dispensing system having the combination of features recited in claim 28.

It is therefore respectfully submitted that independent claim 28 is allowable over the art of record.

Independent claims 29-45 and 52-54 also define operator assisted prescription dispensing systems that include either (in some cases both) interaction with the operator or simultaneously counting out the pills, while sequentially dispensing the pills. As previously stated, these features, when viewed in combination with the remaining elements (or steps/features) of independent claims 29-45 and 52-54, are simply not shown or in any way suggested by any of the applied references, taken individually or in combination.

It is therefore respectfully submitted that independent claims 29-45 and 52-54 are allowable over the art of record.

Claims 46-51 depend from independent claims 28-45, and are therefore believed allowable for at least the reasons set forth above with respect to independent claims 28-45. In addition, these claims each introduce novel elements that independently render them patentable over the art of record. For example, claim 46 indicates that "each of said pill dispensers signals the operator to assist in dispensing the pills when ready." This feature, in combination with the additional elements of claims 28-45, is not shown or suggested by the art of record.

Claim 47 further includes "a plurality of output hoppers one for each of said pill dispensers to receive the pills counted out by said pill dispensers, output snouts, one connected to each of said output hoppers, said controller controlling the selective release of the pills from said output hoppers through the corresponding output snouts, said output snouts being arranged in at

least one row and defining an aisle extending adjacent to and parallel to said row to permit the operator to have ease of access to pills dispensed through said snouts," in combination with the features of claims 28-45. Claim 51 further requires that "said controller indicates to the operator when a hopper quantity of at least one of said dispensers requires refilling responsive to predetermined criteria and increases the hopper quantity for the at least one dispenser when the pills are added to a supply hopper of the at least one dispenser by a number of pills," in combination with the features of claims 28-45.

Claims 55-72 are newly presented and define article dispensing systems. In particular, the article dispensing systems defined by claims 58, 63-65, and 70 define operator assisted systems requiring interaction with an operator. Claims 55-72 include broader aspects of independent claim 20 that was allowed and issued without any comment by Applicants, and therefore, the broader aspects were not surrendered during prosecution of U.S. Patent 5,720,154, and to which Applicants are entitled protection. Furthermore, the combination of features defined by claims 55-72 is not shown or suggested by the prior art.

It is therefore respectfully submitted that claims 55-72 are allowable over the art of record.

For the reasons stated above, it is respectfully submitted that all of the pending claims are now in condition for allowance. The Examiner is respectfully requested to contact the undersigned, if it is believed that such contact would further the examination of the present application.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees that may be required for this Amendment, or credit any overpayment, to deposit account number 08-0219.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of which is required to make this response timely, and is hereby authorized to charge any fee for such, to deposit account number 08-0219.

Respectfully Submitted,

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